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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,095	08/22/2005	Kimio Ishimaru	4752-004	4555
23429 7590 01/06/2009 LOWE HAUPTMAN HAM & BERNER, LLP 1700 DIAGONAL ROAD SUITE 300 ALEXANDRIA, VA 22314				
EXAMINER				
TROTTER, SCOTT S				
ART UNIT		PAPER NUMBER		
3694				
MAIL DATE		DELIVERY MODE		
01/06/2009		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/521,095

Applicant(s)

ISHIMARU ET AL.

Examiner

SCOTT S. TROTTER

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 11, 12, 14, 17, 18, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 13, 15, 16, 19 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date September 2, 2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Restriction election

1. The Office acknowledges the receipt of Applicant's restriction election, filed October 29, 2008. Applicant elects Group I, claims 1-10, 13, 15, 16, 19 and 20, without traverse. Claims 1-22 are pending. Claims 11, 12, 14, 17, 18, 21, and 22 are nonelected. Claims 1-10, 13, 15, 16, 19 and 20 are examined in the instant application. This restriction is made FINAL.

Specification

2. The abstract of the disclosure is objected to because it is longer than the 150 word limit. Correction is required. See MPEP § 608.01(b).

Information Disclosure Statement

3. An initialed and dated copy of Applicant's IDS form 1449 filed September 2, 2005, is attached to the instant Office action. The January 13, 2005 IDS was not included because the September 2, 2005 IDS included all of its references making it superfluous.

Claim Rejections - 35 USC § 101 Utility

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-10, 13, 15, and 16, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876) and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (The Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)) If neither of these requirements is met by the claim, the method is not a patent eligible process under § 101 and should be rejected as being directed to nonstatutory subject matter. In the present case the claims are for a method for selling that does not involve any particular apparatus or any transformation to a different state or thing therefore these claims are rejected as nonstatutory. Claims 15 and 16 are software per se claims which are only allowed when fixed on a computer readable medium as in claims 19 and 20.

Claim Rejections - 35 USC § 112, first paragraph

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

17. Claims 1-10, 13, 15, 16, 19 and 20 are rejected under 35 U.S.C. 112, first paragraph. Specifically, one skilled in the art clearly would not know how to use the claimed invention because one skilled in the art would not know what expected results information to use without undue experimentation. Determining expected results appears to be making educated guesses which by definition requires undue experimentation.

The general rule for "Undue Experimentation" is if the factors indicate undue experimentation is required for the use of the invention by considering the a.) breadth of the claims, b.) nature of the invention, c.) state of the prior art, d.) level of one of ordinary skill, e.) the level of predictability in the art, f.) amount of direction provided by the inventor, and g.) the quantity of experimentation needed to use the invention then the claimed invention will be unpatentable. In re Wands, 858 F.2d 731, 737 (Fed. Cir. 1988).

i. Here, while the breadth of the claims factor is reasonable because the invention is focused on selling securities. That reasonableness is not sufficient to overcome the scant disclosure regarding how they are predicting the future.

ii. Here, the nature of the invention factor is satisfied because the expected values will vary widely based on the many different methods of determining the expected values and possible assumptions that go into such determinations ie. is the market for cell phones growing, stable or shrinking? Will affect the projections of what a new cell phone projected to capture ten percent of the market will earn. With that ten percent projection being dependent on its own assumptions.

iii. As for the state of the prior art predicting the future has always had a very limited level of success with weather predictions for a couple of days away being relatively dependable but two months or two years away being laughable. Market predictions have not been particularly better or the Ford Edsel and many other products would never have been built.

iv. Here, the level of one of ordinary skill factor is satisfied because most people can not tell a good prediction of the future from a bad prediction of the future until after the fact.

v. Here, the amount of direction provided by the inventor factor is satisfied because the inventor does not rank, prioritize, suggest, or indicate how the expected results will be arrived at. The Application only indicates that expected results will be used, recommendations will be produced and presented to the user without any direction requiring undue experimentation by the user.

vi. Therefore, there is "Undue Experimentation" because all of the factors weigh in to conclude that significantly more experimentation is required based on the facts presented in the application and prior art.

Conclusion

7. Examiner's Note: The Examiner has cited particular columns and line numbers in the references as applied to the claims for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.
8. Any inquiry concerning this communication from the examiner should be directed to Scott S. Trotter, whose telephone number is 571-272-7366. The examiner can normally be reached on 8:30 AM – 5:00 PM, M-F.
9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell, can be reached on 571-272-6712.
10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
11. The fax phone number for the organization where this application or proceeding is assigned are as follows:

Art Unit: 3694

(571) 273-8300 (Official Communications; including After Final
Communications labeled "BOX AF")

(571) 273-6705 (Draft Communications)

sst

1/6/2009

/James P Trammell/

Supervisory Patent Examiner, Art Unit 3694